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EXAMINER

LONG, FONYA M

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/820,193	<b>Applicant(s)</b> BEALKE ET AL.	
	<b>Examiner</b> FONYA LONG	<b>Art Unit</b> 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This communication is a second Non-Final Office Action on the merits. Claims 1, 4, and 5 have been amended. Claim 8 has been canceled. Claims 9-26 have been added. Claims 1-7 and 9-26 are currently pending and have been addressed below.

#### ***Response to Amendment***

1. Applicant's amendments to the claims are sufficient to overcome the 112 2<sup>nd</sup> rejections set forth in the previous office action.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 14-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

**As per Claims 14 and 15**, the claims recite the limitation "the expert being precluded from obtaining information regarding the outcome of the claim". However, the written description fails to disclose this limitation and the process of how the expert is precluded from the outcome of the claim.

**As per Claim 16**, the claim recite the limitation “the expert is retained prior to the filing of any litigation by said retaining party or another party adverse to said retaining party”. However, the written description fails to disclose this limitation and the process of retaining the expert prior to filing a litigation.

**As per Claim 17**, the claim recite the limitation “said objective evaluation includes an objective monetary valuation of the claim”. However, the written description fails to disclose this limitation and the process of determining the monetary valuation of the claim.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 5 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**As per Claim 5**, the claim provide the limitation of stating that the standard of care was met and stating that the standard of care was not met. It is unclear how a standard can be met and not met at the same time. The written description fails to provide an explanation on how the standard of care can be met and not met at the same time.

**As per Claim 26**, the claim provide the limitation “assuming, for each board-certified who rendered care to the claimant, that the physician’s retention of such certification depends on whether the treatments rendered by the physician met the appropriate standards of care for a board-certified physician treating said medical conditions”. The limitation fails to provide a **definite** limitation as a method step. The

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claim recites "assuming". It is unclear who or what is assuming. It is unclear what is being claimed.

### ***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-7 and 9-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter. With respect to claims 1-7 and 9-26, the claim language does not include the required tie or transformation and thus is directed to nonstatutory subject matter.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1 and 9-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (5,862,223) in view of Rackman (5,903,646).

**As per Claim 1**, Walker et al. discloses a double blind evaluation method (Col. 20, Lines 50-65, discloses a method of providing anonymity when requesting and providing an expert opinion), comprising the steps of:

retention by an entity having a direct or indirect interest in the claim of a neutral third party to obtain an independent evaluation of the claim (Col. 7, Lines 6-29, discloses retention of a neutral third party via a person accessing an online Exchange (i.e. neutral third party) to obtain an independent expert opinion);

acquisition by the third party of facts relating to the claim which are sufficient to permit an independent objective evaluation of the claim (Col. 7, Lines 6-29, discloses the online Exchange acquiring a full description of the job to be performed and any other information necessary to respond to the expert request submitted by the user to be given to the expert for evaluation);

retention by the third party of a qualified independent expert to perform the claim evaluation (Col. 21, Lines 27-36, discloses a retention of an expert by the online Exchange submitting a request to an expert and the expert accepting the request by submitting an acceptance message to the central controller);

submission by the third party of the sufficient facts after redaction to the expert in order to permit the expert to make an independent objective evaluation of the claim (Col. 21, Lines 12-26, discloses the online Exchange submitting an expert request to the

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qualifying expert where (Col. 7, Lines 6-29) the expert request includes a full description of the job to be performed and any other information necessary to respond to the expert request);

preparation by the expert of a written independent objective evaluation of the claim (Col. 21, Lines 37-61, discloses an expert preparing a written independent evaluation via developing an expert answer in response to the request);

submission of the written claim evaluation by the expert to the third party (Col. 21, Lines 37-61, discloses the expert submitting an expert answer to the online Exchange); and

submission of the redacted evaluation to the entity retaining the third party (Col. 21, Lines 37-61, discloses submitting the expert answer to the entity retaining the third party (i.e. online Exchange)).

However, Walker et al. fails to explicitly disclose redaction of information from a document.

Rackman discloses an access control system for litigation document production with the concept of redaction by the third party of information from a document (Col. 1, Line 60-Col. 2, Line 21, discloses redacting privileged information from a document).

Therefore, from the teaching of Rackman, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method and apparatus to facilitate and support expert-based commerce of Walker et al. to include redaction of information from a document as taught by Rackman in order to maintain

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anonymity and security by redacting privileged and identifying information from documents exchanged.

**As per Claim 9**, Walker et al. discloses a method for evaluating a malpractice claim, comprising:

receiving, from a retaining party, a set of facts relating to the claim, said set of facts including facts sufficient to permit an objective evaluation of the claim (Col. 7, Lines 6-29, discloses the online Exchange acquiring a full description of the job to be performed and any other information necessary to respond to the expert request submitted by the user to be given to the expert for evaluation);

selecting an independent, neutral medically trained expert to evaluate the claim (Col. 21, Lines 27-36, discloses the selection of an expert by the online Exchange submitting a request to an expert and the expert accepting the request by submitting an acceptance message to the central controller);

providing the set of redacted facts to the expert for evaluation (Col. 21, Lines 12-26, discloses the online Exchange submitting an expert request to the qualifying expert where (Col. 7, Lines 6-29) the expert request includes a full description of the job to be performed and any other information necessary to respond to the expert request); and

receiving, from the expert, an objective evaluation of the claim based on said set of redacted facts (Col. 21, Lines 37-61, discloses the expert submitting an expert answer to the online Exchange); and



providing said redacted objective evaluation to the retaining party (Col. 21, Lines 37-61, discloses submitting the expert answer to the entity retaining the third party (i.e. online Exchange)).

However, Walker et al. fails to explicitly disclose redaction of information from a document.

Rackman discloses an access control system for litigation document production with the concept of redaction by the third party of information from a document (Col. 1, Line 60-Col. 2, Line 21, discloses redacting privileged information from a document).

Therefore, from the teaching of Rackman, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method and apparatus to facilitate and support expert-based commerce of Walker et al. to include redaction of information from a document as taught by Rackman in order to maintain anonymity and security by redacting privileged and identifying information from documents exchanged.

**As per Claims 10 and 11**, the Walker et al. and Rackman combination discloses the claimed invention as applied to Claim 9, above. However, the combination fails to explicitly disclose the retaining party as a claimant or a claimant's representative; or an insurance company or an insurance company's representative.

Examiner asserts the identity of the retaining party is considered non-functional descriptive information. The fact that the retaining party is a claimant, a claimant's representative, an insurance company, or an insurance company's representative does not change the function of the claimed invention. Examiner asserts that the Walker et al.

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and Rackman combination is fully capable of utilizing a retaining party as a claimant, a claimant's representative, an insurance company, or an insurance company's representative.

**As per Claims 12 and 13**, Walker et al. discloses an expert being selected at least in part based on having a medical board certification and a professional registration in a medical specialty related to one or more treatments or conditions identified in the claim (Col. 20, Lines 50-65, discloses providing an expert opinion in regards to medical malpractice. Col. 25, Line 35-Col. 26, Line 14, discloses an expert being selected based on the expert qualifications).

Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to expert qualifications be medical board certification and professional registration. It is well known in the legal profession and field to qualify a witness and an expert witness based on certifications and professional registrations when wanted to enter expert opinions into evidence.

**As per Claims 14 and 15**, the Walker et al. and Rackman combination discloses the claimed invention as applied to Claim 9, above. However, the combination fails to explicitly disclose the expert being precluded from obtaining any information regarding the outcome of the claim.

Examiner asserts it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the expert be precluded from obtaining any information regarding the outcome of the claim in order to maintain the integrity of the expert-based system by providing education expert opinions absent bias.

**As per Claim 16**, the Walker et al. and Rackman combination discloses the claimed invention as applied to Claim 9, above. However, the combination fails to explicitly disclose the expert being retained prior to the filing of any litigation.

Examiner asserts that the expert being retained prior to the filing of any litigation is considered non-functional descriptive material. The fact that the expert is retained prior to the filing of any litigation does not change the function of the claimed invention. Examiner asserts the Walker et al. and Rackman combination is fully capable of obtaining an expert prior to filing a litigation.

**As per Claim 17**, the Walker et al. and Rackman combination discloses the claimed invention as applied to Claim 9, above. However, the combination fails to explicitly disclose the objective evaluation including an objective monetary valuation of the claim.

Examiner asserts that the objective evaluation including an objective monetary valuation of the claim is considered non-functional descriptive material. The information contained in the objective valuation provided to the retaining party does not change the function of the claimed invention. Examiner asserts that the Walker et al. and Rackman combination is fully capable of utilizing an objective evaluation having an objective monetary valuation of the claim.

10. Claims 2, 3, and 18-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (5,862,223) in view of Rackman (5,903,646) as applied to claims 1 and 9 above, and further in view of *Medical Experts & Establish Standards of Care in Malpractice Cases* (November 21, 2000).

**As per Claim 2**, the Walker et al. and Rackman combination discloses the claimed invention as applied to Claim 1, above. However, the combination fails to explicitly disclose acquiring a plurality of the following: facts and documents that relate to the claim; background information about the party asserting the claim; background information about the party against whom the claim is asserted; and facts about the party's peer group in the same geographic area.

*Medical Experts & Establish Standards of Care in Malpractice Cases* discloses that an expert witness must assert familiarity with the treatment of patients with the plaintiff's complaint by physicians similarly situated to the defendant and that an expert witness may offer an opinion as to whether the defendant (i.e. physician) was qualified to treat the plaintiff's condition. It would have been obvious to one of ordinary skill in the art at the time the invention was made to obtain facts and documents that relate to the claim and background information about the party asserting the claim (i.e. patient) and about the party against whom the claim is asserted (i.e. physician) in order for the expert to develop a conclusion as to whether based on the plaintiff's condition and the defendant's actions the defendant did not meet the standard of care and as to whether the defendant was qualified to treat the plaintiff.

Therefore, from the teaching of *Medical Experts & Establish Standards of Care in Malpractice Cases*, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Walker et al. and Rackman combination to include acquiring a plurality of the following: facts and documents that relate to the claim; background information about the party asserting the claim; background

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information about the party against whom the claim is asserted; and facts about the party's peer group in the same geographic area as taught by *Medical Experts & Establish Standards of Care in Malpractice Cases* in order to provide the expert with information that would enable the expert to provide an informed expert opinion.

**As per Claim 3**, the Walker et al. and Rackman combination discloses the claimed invention as applied to Claim 2, above. However, the combination fails to explicitly disclose a plurality of the following types of information: resumes; at least one curriculum vitae; educational history; employment history; and professional training.

*Medical Experts & Establish Standards of Care in Malpractice Cases* discloses an expert witness offering an opinion as to whether the defendant (i.e. physician) was qualified to treat the plaintiff's condition. It would have been obvious to one of ordinary skill in the art at the time the invention was made to obtain information about the defendant such as training, employment history, and education in order for the expert to determine based on the information provided whether the defendant was qualified to treat the plaintiff's condition.

Therefore, from the teaching of *Medical Experts & Establish Standards of Care in Malpractice Cases*, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Walker et al. and Rackman combination to include disclose a plurality of the following types of information: resumes; at least one curriculum vitae; educational history; employment history; and professional training as taught by *Medical Experts & Establish Standards of Care in Malpractice Cases* in order

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to provide the expert with information that would enable the expert to provide an informed expert opinion.

**As per Claims 18 and 20** , the Walker et al. and Rackman combination discloses the claimed invention as applied to Claim 9, above. However, the combination fails to explicitly disclose the objective evaluation including a description of relevant standards of care.

*Medical Experts & Establish Standards of Care in Malpractice Cases* discloses an expert providing a description of relevant standards of care for one or more medical conditions or treatments associated with the claim (Page 1, discloses the expert establishing a standard for medical care and giving an opinion on whether the defendant's conduct met this standard), wherein said relevant standards of care include at least one of a local or regional standard of care and one of a national standard of care (Page 2, discloses a national standard of care).

Therefore, from the teaching of *Medical Experts & Establish Standards of Care in Malpractice Cases*, it would have been obvious to one of ordinary skill in the art at the time the invention to modify the Walker et al. and Rackman combination to include the objective evaluation including a description of relevant standards of care as taught by *Medical Experts & Establish Standards of Care in Malpractice Cases* in to provide an informed expert opinion.

Examiner asserts the that the standard of care including a gold standard of care is considered non-functional descriptive material. The standard of care including a gold standard of care does not change the function of providing an objective evaluation.

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Examiner asserts the Walker et al., Rackman, and *Medical Experts & Establish Standards of Care in Malpractice Cases* is fully capable of utilizing a gold standard of care.

**As per Claims 19 and 21**, the Walker et al. and Rackman combination discloses the claimed invention as applied to Claim 9, above. However, the combination fails to explicitly disclose citations from medical literature related to each of said relevant standards of care.

*Medical Experts & Establish Standards of Care in Malpractice Cases* discloses citations from medical literature related to each of said relevant standards of care (Page 1, via an expert witness opinion must be supported by uncontroverted scholarly literature).

Therefore, from the teaching of *Medical Experts & Establish Standards of Care in Malpractice Cases*, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Walker et al. and Rackman combination to include citations from medical literature as taught by *Medical Experts & Establish Standards of Care in Malpractice Cases* in order to provide scientific support to the expert's opinion in determining whether a defendant violated the standard of care.

**As per Claim 22**, the Walker et al. and Rackman combination discloses the claimed invention as applied to Claim 9, above. However, the combination fails to disclose a description of one or more standards of care; and one or more arguments why the treatment rendered did or did not meet the one or more applicable standard of care.

*Medical Experts & Establish Standards of Care in Malpractice Cases* discloses a description of one or more standards of care applicable to a treatment associated with the claim; one or more arguments why the treatment rendered met the one or more applicable standards of care; and one or more arguments why the treatment rendered did not meet the one or more applicable standards of care (Page 1, via an expert witness establishing a standard for medical care and giving an opinion on whether the defendant's conduct did or did not meet this standard and supporting his opinion by uncontroverted scholarly literature).

Therefore, from the teaching of *Medical Experts & Establish Standards of Care in Malpractice Cases*, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Walker et al. and Rackman combination to include a description of one or more standards of care; and one or more arguments why the treatment rendered did or did not meet the one or more applicable standard of care as taught by *Medical Experts & Establish Standards of Care in Malpractice Cases* in order to provide an informed expert opinion.

**As per Claim 23**, the Walker et al. and Rackman combination discloses the claimed invention as applied to Claim 22, above. However, the combination fails to explicitly disclose providing for each of said arguments, a citation to the medical literature.

*Medical Experts & Establish Standards of Care in Malpractice Cases* discloses citations from medical literature related to each of said relevant standards of care (Page



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1, via an expert witness opinion must be supported by uncontroverted scholarly literature).

Therefore, from the teaching of *Medical Experts & Establish Standards of Care in Malpractice Cases*, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Walker et al. and Rackman combination to include citations from medical literature as taught by *Medical Experts & Establish Standards of Care in Malpractice Cases* in order to provide scientific support to the expert's opinion in determining whether a defendant violated the standard of care.

**As per Claim 24**, the Walker et al. and Rackman combination discloses the claimed invention as applied to Claim 9, above. However, the combination fails to explicitly disclose the objective evaluation including a description of a suggested court treatment.

Examiner asserts the contents contained in the objective evaluation is considered non-functional descriptive material. The objective evaluation having a description of a suggested course of treatment does not change the function of the claimed invention. Examiner asserts the Walker et al. and Rackman combination is fully capable of utilizing an objective evaluation including a description of a suggested course of treatment.

**As per Claim 25**, the Walker et al. and Rackman combination discloses the claimed invention as applied to Claim 9, above. However, the combination fails to explicitly disclose selecting one or more standards of care and providing an objective evaluation based on the standard of care.

*Medical Experts & Establish Standards of Care in Malpractice Cases* discloses said objective evaluation is prepared by said expert by:

selecting one or more standards of care applicable to one or more medical treatments associated with the claim (Page 1, discloses the expert establishing a standard of care and giving an opinion on whether the defendant's conduct met this standard of care);

assuming, for each board-certified physician who rendered care to the claimant, that the physician's retention of such certification depends on whether the treatments rendered by the physician met the appropriate standards of care for a board-certified physician treating said medical conditions; and

including, in said objective evaluation:

a description of the one or more medical treatments rendered by the board-certified physician;

the selected standard or standards of care applicable to said one or more medical treatments;

an opinion regarding whether each of said one or more medical treatments rendered met the selected standard or standards of care; and

an explanation for each opinion (Page 1, discloses the expert providing a standard of care and an opinion on whether the defendant's conduct met this standard, which is supported by uncontroverted scholarly literature (i.e. explanation of opinion).

Therefore, from the teaching of *Medical Experts & Establish Standards of Care in Malpractice Cases*, it would have been obvious to one of ordinary skill in the art at the

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time the invention was made to modify the Walker et al. and Rackman combination to include selecting one or more standards of care and providing an objective evaluation based on the standard of care as taught by *Medical Experts & Establish Standards of Care in Malpractice Cases* in order to provide an informed opinion.

**As per Claim 26**, the Walker et al. and Rackman combination discloses the claimed invention as applied to Claim 25, above. However, the combination fails to disclose one or more citations of medical literature.

*Medical Experts & Establish Standards of Care in Malpractice Cases* discloses citations of medical literature supporting each opinion (Page 1, via an expert witness opinion must be supported by uncontroverted scholarly literature).

Therefore, from the teaching of *Medical Experts & Establish Standards of Care in Malpractice Cases*, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Walker et al. and Rackman combination to include citations from medical literature as taught by *Medical Experts & Establish Standards of Care in Malpractice Cases* in order to provide scientific support to the expert's opinion in determining whether a defendant violated the standard of care.

11. Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (5,862,223) in view of Rackman (5,903,646) as applied to claim 1 above, and further in view of *Liebig-Grigsby v. United States of America* (March 12, 2003) and *Medical Experts & Establish Standards of Care in Malpractice Cases* (November 21, 2000).

**As per Claim 4**, the Walker et al. and Rackman disclose the claimed invention as applied to Claim 1, above.

*Liebig-Grigsby v. United States of America* discloses an expert witness providing an expert opinion with the concept of wherein preparation by the expert of a written independent objective evaluation of the claim comprises:

stating medical cause of claimant's condition (Page 4, discloses the expert Dr. Wilberger stating the medical cause of the Plaintiff's condition as cervical myelopathy);

stating whether there was any action/inaction by the claimant which can be attributed to or cited as the cause of current condition, listing by symptoms and/or cause (Pages 9 and 10, discloses the expert stating that due to the failure to refer the Plaintiff to a neurosurgeon and due to the neurosurgeon not ordering an MRI, the physicians deprived the Plaintiff of the opportunity for an intervention that could have stabilized or perhaps improved the Plaintiff's condition. As a result, the Plaintiff's condition deteriorated to the point where the Plaintiff is currently confined to a wheelchair); and

stating the identity of each provider providing treatment to the claimant (Pages 9 and 10, discloses the expert Dr. Wilberger, identifying Dr. Garmon, and Dr. Orfei as the physicians who provided treatment to the Plaintiff) and, for each provider,

stating each symptom/cause treated by that provider and the treatment rendered to claimant (Pages 4-9, via the findings of fact disclosing the expert Dr. Wilberger stating the Plaintiff's medical conditions (i.e. symptom/cause) and (Pages 9-11) Dr. Wilberger stating the treatment (or lack of treatment) that was provided by each physician (i.e. Dr. Orfei and Dr. Garmon)).

Therefore, from the teaching of *Liebig-Grigsby v. United States of America*, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Walker et al. and Rackman combination to include stating a medical cause; stating whether there was any action/inaction by the claimant; stating the identity of each provider; and stating each symptom/cause treated as taught by *Liebig-Grigsby v. United States of America* in order to aid in providing an expert opinion for a medical malpractice claim.

However, *Liebig-Grigsby v. United States of America* fails to explicitly disclose the expert providing citations from medical literature and stating at least one argument why each treatment actually rendered did or did not meet the applicable standard of care.

*Medical Experts & Establish Standards of Care in Malpractice Cases* discloses the requirements for an expert witness with the concept of the expert providing citations from medical literature (Page 1, via an expert witness opinion must be supported by uncontroverted scholarly literature); and the expert stating at least one argument why each treatment actually rendered did or did not meet the applicable standard of care, and providing citations from medical literature for all arguments (Page 1, via an expert witness establishing a standard for medical care and giving an opinion on whether the defendant's conduct did or did not meet this standard and supporting his opinion by uncontroverted scholarly literature).

Therefore, from the teaching of *Medical Experts & Establish Standards of Care in Malpractice Cases*, it would have been obvious to one of ordinary skill in the art at the

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time the invention was made to modify the Walker et al., Rackman, and *Liebig-Grigsby v. United States of America* combination to include the expert providing citations from medical literature and stating at least one argument why each treatment actually rendered did or did not meet the applicable standard of care as taught by *Medical Experts & Establish Standards of Care in Malpractice Cases* in order to provide scientific support to the expert's opinion in determining whether a defendant violated the standard of care.

**As per Claim 5**, the Walker et al., Rackman, and *Liebig-Grigsby v. United States of America* combination discloses the claimed invention as applied to Claim 4, above. However, the combination fails to explicitly disclose the expert stating at least one argument why each treatment actually rendered did and did not meet the applicable standard of care and providing citations from medical literature for all arguments.

*Medical Experts & Establish Standards of Care in Malpractice Cases* discloses the requirements for an expert witness with the concept of the expert stating at least one argument why each treatment actually rendered did and did not meet the applicable standard of care, and providing citations from medical literature for all arguments (Page 1, via an expert witness establishing a standard for medical care and giving an opinion on whether the defendant's conduct did or did not meet this standard and supporting his opinion by uncontroverted scholarly literature). It would be obvious to one of ordinary skill in the art at the time of the invention to have an expert state when a treatment rendered met a standard of care and also state when a treatment rendered did not meet a standard of care in order to provide a clear analysis as to what was the cause of the

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claimants injuries and to determine what specific actions should the defendant be held accountable for as a violation of the standard of care.

Therefore, from the teaching of *Medical Experts & Establish Standards of Care in Malpractice Cases*, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Walker et al., Rackman, and *Liebig-Grigsby v. United States of America* combination to include the stating at least one argument why each treatment actually rendered did and did not meet the applicable standard of care and providing citations from medical literature for all arguments as taught by *Medical Experts & Establish Standards of Care in Malpractice Cases* in order to provide scientific support to the expert's opinion in determining whether a defendant violated the standard of care.

**As per Claims 6 and 7**, the Walker et al. and Rackman combination discloses the claimed invention as applied to Claims 4 and 5, above.

*Liebig-Grigsby v. United States of America* discloses the expert stating the treatment that the expert would have selected to be rendered to the claimant, given the claimant's symptom and/or cause (Page 9, discloses the expert Dr. Wilberger stating the he would have rendered a second surgery to the claimant based on the conditions of the claimant).

However, *Liebig-Grigsby v. United States of America* fails to explicitly disclose the expert providing citations from medical literature.

*Medical Experts & Establish Standards of Care in Malpractice Cases* discloses the requirements for an expert witness with the concept of the expert providing citations

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from medical literature (Page 1, via an expert witness opinion must be supported by uncontroverted scholarly literature).

Therefore, from the teaching of *Medical Experts & Establish Standards of Care in Malpractice Cases*, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Walker et al., Rackman, and *Liebig-Grigsby v. United States of America* combination to include the expert providing citations from medical literature as taught by *Medical Experts & Establish Standards of Care in Malpractice Cases* in order to provide scientific support to the expert's opinion in determining whether a defendant violated the standard of care.

### ***Response to Arguments***

12. Applicant's arguments filed October 10, 2008 have been fully considered but they are not persuasive.

**As per Claim 1**, Applicant's arguments, see pages 12-14, filed October 10, 2008, with respect to the rejection of claim 1 under 102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Rackman (5,903,646).

**As per Claim 2**, Applicant argues Medical Expert fails to disclose specific steps or analysis used by such expert witnesses to evaluate medical conditions. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., specific steps or



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analysis used by such expert witnesses to evaluate medical conditions) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can may be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Walker et al. discloses providing anonymity for the expert and the retaining party when providing and obtaining an expert opinion. Medical Experts discloses the problem of expert fulfilling the desired needs of the lawyer rather than facing the core problems of inadequately defined practice standards and the need for a solution.

In addition, the expert being non-neutral or neutral is considered non-functional descriptive material. The type of expert providing the opinion does not change the function of the claimed invention.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was

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within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

**As per Claim 3**, In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

**As per Claim 4**, Applicant argues Liebig fails to disclose the expert stating whether there was any action/inaction by the claimant rather than the defendant. Examiner asserts that the fact that the action/inaction is by the claimant rather than the defendant is considered non-functional descriptive material. The action/inaction being by the claimant does not change the function stating whether an action/inaction occurred.

**As per Claim 5**, Applicant argues that Medical Experts fail to disclose providing arguments as to why the treatment did meet the standard of care as well as arguments as to why the treatment did not meet the standard of care. Examiner asserts it is unclear how the standard of care can be met and not met at the same time and event. A

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statement as to whether a standard of care is met either has to be in the affirmative or the negative. Medical Expert discloses providing an opinion on whether the standard of care was met (Page 1, Para. 2).

**As per Claims 6 and 7**, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

### ***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to FONYA LONG whose telephone number is (571)270-5096. The examiner can normally be reached on Mon-Thur 7:30am-6:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on (571) 272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/F. L./

Examiner, Art Unit 3689

/Tan Dean D. Nguyen/

Primary Examiner, Art Unit 3689